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EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/931,721

Applicant(s)

BRANDENBERGER ET AL.

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/20/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At least in claim 1: how is the manager report “generated”? What technology is being used to generate the report?

In claims 2, 11, 26, 41: What does the word “value” mean the context of these claims? One of ordinary skill the art would not be able to know what is considered “reasonable” in the context of the claim.

In claims 15, 30, 45: What is the difference between “quantitative” and “qualitative” factors? What factors are you referring to? One of ordinary skill in the art would not know what criteria makes up quality and/or quantity factors and “quality” data.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-18, 21-33 and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US 6,018,722) in view of Lauffer (US 6,223,165)

Ray discloses Accessing a database (see fig. 4, col. 6, ll. 12-30; and col. 8, ll. 22-30)-see

*Claims 1, 13, 16*

Entering asset manager data in a section of an asset manager questionnaire, the asset manager questionnaire including a plurality of sections (see col. 6, ll. 12-30; and col. 4, ll. 62+)-see *Claims 1, 13, 16, 28, 31, 42*

Sorting, in a database, entered asset manager data from the questionnaire (see fig. 6, col. 3, ll. 56-60; col. 4, ll. 61 to col. 5, ll. 48)-see *Claims 1, 13, 16, 28, 31*

Comparing asset manager data with data of at least another asset manager (see col. fig. 3, col. 3, ll. 46-50)-see *Claims 1, 13, 16*

Generating a manager report of the compared data corresponding to the plurality of sections for the asset manager and the at least another asset manager (see Abstract)-see *Claims 1, 13, 16, 31*

Displaying, in the manager report, at least one of median, smallest and largest value of the compared data for at least section of the plurality of sections. This is considered unpatentable because it is merely displaying the smallest and largest value optimum ranges [see *In re Aller*, 105 USPQ 233, 235; 220 F2d 454 (CCPA 1955)]-*see Claims 2, 3, 17, 18*

Displaying a comparison, in the manager report, of the compared data for at least one selection of the plurality of sections (see col. 5, ll. 21-47)-*Claims 2, 3, 17, 18, 32, 33*

Sections of the questionnaire comprise at least one of the organizational information, products managed by the asset manager, and product details (see col. 4, ll. 66 to col. 5, ll. 19)-*Claims 6, 36, 37*

The product section includes at least one category, the at least one category being one of equity bonds, hedge funds and commodities (see col. 4, ll. 66 to col. 5, ll. 19)- *Claims 10, 25, 40*

Further comprising displaying a comparison, in the manager report, of at least one organization information, products and product details of the asset manager and the at least another asset manager (see Ray, col. 1, ll. 56 to col. 3, ll. 35)-*Claim 7*

Displaying a comparison in the manger report, of at least one of performance, risk measures, fees and volume of the asset manager's and the at least another asset manager's respective products (see Ray, col. 1, ll. 56 to col. 3, ll. 35)-*Claim 8*

Displaying in the manager report, information on the asset manager's and the at least another manager's respective assets under management, active portfolio volume, number of accounts active, passive portfolio volume, number of passive accounts and preferences for a product custodian. (see Ray, col. 1, ll. 56 to col. 3, ll. 35)- *Claim 9*

Art Unit: 3624

The manager report further comprises a comparison of at least one of performance, risk measures, fees and volume of the asset manager's and the at least another asset manager's respective modules (see Ray, col. 1, ll. 56 to col. 3, ll. 35) –*Claims 23, 38*

The manager report further comprises information on the asset manager's and the at least another asset manager's respective assets under management, active portfolio volume, number of accounts active, passive portfolio volume, number of passive accounts, and preferences for a product custodian (see Ray, col. 1, ll. 56 to col. 3, ll. 35)–*Claims 24, 39*

Ray does not disclose matching of the first data corresponding to the entered plurality of investor preferences and the second data corresponding to the entered criteria with asset manager data and data entered by the least another asset manager. Lauffer discloses matching entered investor preferences (consumer queries) from the customer with data corresponding to second data characteristics (see Lauffer, Abstract, col. 5, ll. 36 to col. 6, ll. 27).

Both Ray and Lauffer are systems which disclose methods in which a consumer/customer/investor may electronically acquire information (advice) from the system over a network. It would have been obvious for an artisan at the time of the invention to consider the fact that in order for Ray to customize a report based upon certain investor preferences, matching of those preferences (to some degree) must take place with the best available advice (at the time of the query) to be given and the appropriate allocation mix to be chosen by the system. The matching embodiment disclosed in Lauffer provides an alternative to create customized reports based upon the plurality of entered investor preferences (see col. 2, ll. 5 to col. 3, ll. 35). An artisan at the time of the invention would have obviously understood the need to provide the most appropriate investments and investment advice, based upon the investors'

Art Unit: 3624

criteria, and thus have sought the teachings of Lauffer to match customer queries (via questionnaires) to the appropriate financial service providers (experts). Thus such a modification would have been an obvious extension of the teaching in Ray of managing securities/portfolios and therefore have been an obvious expedient well within the ordinary skill in the art.

The information provided in the product details section to include at least one category being one of product specification, assets under management, responsible portfolio manager, account size and cost, investment team, investment philosophy, references list, management style, decision factors, actively steered parameters, approach for passive products, expected results and performance data and standards can be found in an a notoriously old and well known investment prospectus. Thus the Official Notice is taken of the product detail section as being an obvious extension to the teachings of Ray and Lauffer based upon the fact that financial service providers are allowed to manage customer accounts and such information would prove valuable to customers in considering investment opportunities. Thus such details would be considered an obvious expedient well within the ordinary skill in the art-*Claims 12, 21, 22, 27, 42*

Art Unit: 3624

3. Claims 4, 5, 19, 20, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US 6,018,722) as modified by Laufer (US 6,223,165) as applied to claim 1 as discussed above, and further in view of Campbell et al (US 6,856,970).

Ray as modified by Laufer discloses the allocation model is derived from the a look up table according to customers answers to a questionnaire, but fails to teach downloading the questionnaire from the database, the questionnaire including the entered data (*see claims 5, 20 and 35*).

Campbell discloses a report is configured to be exported into a spreadsheet program-(see Campbell Abstract, col. 28, ll. 44 to col. 29, ll. 34)-*Claims 4, 19, 34; and*

Downloading the electronic asset manager questionnaire from the database; and uploading, to the database, the asset manager questionnaire including entered asset manager data; wherein said entering asset manager data occurs in the downloaded questionnaire--(see Campbell Abstract, col. 28, ll. 44 to col. 29, ll. 34)-*Claim 5, 20, 35*

Since Ray also discloses transmitting and receiving information via a network (see col. 3, ll. 4+), it would have been obvious for an artisan at the time of the invention to substitute the look-up table with the spreadsheet because an artisan at the time of the invention would have recognized the look-up table and the spreadsheet as art recognizes equivalents to transmit and provide data into reports. Thus such a modification would be considered an obvious expedient well within the ordinary skill in the art.



Art Unit: 3624

generating a manager feedback analysis report including factors determined important by the investor, based on feedback given by the investor. *Claims 14, 29, 44*

*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel S Felten  
Examiner  
Art Unit 3624



DSF  
March 01, 2005

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